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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,892	07/09/2001	Stephen Carl McKeown	PG3576USW	7728

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DAVID J LEVY, CORPORATE INTELLECTUAL PROPERTY
GLAXOSMITHKLINE
FIVE MOORE DR., PO BOX 13398
RESEARCH TRIANGLE PARK, NC 27709-3398

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Office Action Summary

Application No.

09/806,892

Applicant(s)

McKeown et al

Examiner

Maurie G. Baker, Ph.D.

Art Unit

1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 24, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) 1-31 and 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>6</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to **Art Unit 1639**.

1. The Response filed March 24, 2003 (Paper No. 9) is acknowledged. No claims were cancelled, amended or added. Therefore, claims 1-37 are pending.

Election/Restriction

2. Applicant's election without traverse of Group XXIII (claim 32) is acknowledged. The election of species of the chemical construct of Example 4 (resin II) is also noted.
3. Claims 1-31 and 33-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.
4. Therefore, claim 32 is under examination.

Claim Objections

5. Claim 32 is objected to because of the following informalities: The claim depends from a non-elected claim (i.e. claim 1), which is improper. Insertion of the appropriate information and definitions from claim 1 is necessary. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 refers to “subjecting a construct comprising a solid support Q having linked thereto groups Y^1R and Y^2R as defined in claim 1”. As it is unclear what constitutes groups Y^1R and Y^2R , the claim is indefinite.

Also, claim 32 recites in the preamble “method for assaying a chemical library”; however, there are no steps directed to assaying of a library. Thus the claim is incomplete as the object of the method is not obtained. This renders the claim indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by Lebl et al (US 5,635,598; of record).

Lebl et al disclose solid phase supports having a variety of differently cleavable linkers attached thereto. See, for example, patented claims 1, 4, 6, 12, 16, 18 & 20-47. Lebl et al disclose “multiply cleavable linkers, in which cleavage of each linker is independent of the cleavage of the others...thus providing for sequential cleavage of the same or different peptide species from a solid support” (column 3, lines 9-15). Specific information for the first and second cleavage reactions is set forth, e.g., in column 3 of the reference, lines 20-67 (see also Section 5.2 beginning in column 11). Specifically, Figure 8 of Lebl shows a set-up where three differently cleavable sites are shown, as well as a fourth site with a coding tag. This reads directly on the claimed solid support having linked thereto groups Y^1R and Y^2R that are differentially releasable. The reference also states that a “releasable linker” releases “peptides to a solution compatible with biological tests” (column 3, lines 5-9). The peptides of Lebl read on the claimed substrate (R). Specific information for the biological testing of the peptides are described in many places in Lebl, see, for example, Section 5.4 in column 14. Testing of libraries using the multiple cleavable linkers of the reference is described in Section 5.4.1; see particularly column 15, lines 12-53 and the examples starting in column 15, line 54, e.g. example denoted (iii).

Status of Claims/Conclusion

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached on (703) 306- 3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
May 22, 2003



**MAURIE GARCIA BAKER PH.D.
PRIMARY EXAMINER**